AMENDMENTS TO THE DRAWINGS

Please replace Figure 21.

Attachment: Replacement Sheet containing a replacement Figure 21.

REMARKS

The foregoing amendments and the following remarks are responsive to the May 2, 2006 Office Action. Claims 122-126 and 128-133 remain pending in the present application, Claims 129-131 having been amended and Claim 127 having been canceled.

In response to the Office Action mailed May 2, 2006, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the foregoing amendments and the following comments.

Bryan *et al.* Does Not Disclose the Medical Hose Kit Recited By Claim 127

Claims 127 and 130-133 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Bryan *et al.* (U.S. Patent No. 5,582,165) ("Bryan"). Applicant respectfully traverses the present rejection. However, to expedite the prosecution of the present application, Applicant has canceled Claim 127 without prejudice or disclaimer and amended Claims 130-133 to depend from Claim 128. Applicant expressly reserves the right to further prosecute the original versions of Claims 127 and 130-133 through continuation practice.

The Medical Hose Kits Recited By Claims 122-126 and 128 Are Not Obvious In View of Bryan

Claims 122-126 and 128 stand rejected under 35 U.S.C. § 103(a) as being obvious in view of Bryan. Applicant respectfully traverses the present rejections.

Bryan is directed to a package for a catheter that may be connected to a fluid source. The catheter is provided in a polyethylene package. The package reconverts to a package for disposal after the catheter is used.

Bryan, however, fails to disclose a sterilized length of suction hose having an inner diameter of about 8mm.

In contrast, Claim 122 recites "a medical kit comprising a sterilized package containing a sterilized length of suction hose, the suction hose having an inner diameter of at least about 8 millimeters."

Claim 124 recites "a medical kit comprising a sterilized package containing a sterilized length of suction hose, the suction hose having an inner diameter of at least about 8 millimeters, wherein the length of suction hose includes first and second ends, and first and second female adapters connected to the first and second ends, wherein the first female adapter is configured to

be connectable with an outlet of a suction device, the outlet having an inner diameter of about 6 millimeters."

Additionally, Claim 128 recites "a medical suction hose kit comprising a sterilized package containing a sterilized length of suction hose, the suction hose having first and second hose ends and a first hose inner diameter, at least a first connector disposed at the first end, the first connector having a first connector end defining first connector inner diameter that is about the same as the first hose inner diameter, the first connector having a second connector inner diameter that is smaller than the first connector inner, wherein the second connector inner diameter is about 6 millimeters and the first connector inner diameter is about 8 millimeters."

With regard to the rejections of these Claims, it was the Examiner's position that that Claims 122, 124, and 128 are obvious because "where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions **would not perform differently** than the prior art device." (Emphasis added). Applicant, however, submits that Claims 122, 124, and 128 recite apparatuses which **perform differently** than the prior art device.

In the "Response to Arguments" section, the Examiner indicated that "applicants assert that the claimed invention would perform differently than that of [Bryan] because this size **permits compatibility with operating room hoses**. This is not persuasive because this is not evidence that it performs differently, only that it is compatible with operating hoses of a certain diameter." (Emphasis added). Applicants submit that this is an incorrect statement of the improved performance offered by the devices of Claims 122, 124, and 128. Rather, Applicant submits, as noted in the previous response, that the devices of Claims 122, 124, and 128 **perform differently**, and more particularly, are better at **preventing blockages during orthopedic surgery**.

For example, the present application, at paragraphs 0232 and 0233, indicates that operating room suction hoses usually have an inner diameter of 6 millimeters. Additionally, the specification discloses that

> **[0238]** However, it has been found that the suction hose 128 that is typically used in operating rooms can become clogged more easily than the suction device 142. Further, it is also been found that clogs within the suction hose 128 can be initiated at deformed portions of the house 128.

. . .

[0240] As shown in Figure 18, the cross-sectional shape of the tubing 128 in certain areas remains round. However, as shown in Figure 19, certain portions of the tubing 128 can become constricted. This deformation can sometimes be found in the curve of the tubing 128 that has been folded for packaging purposes so that the tubing 128 fits within the package 154. Additionally, various portions of the tubing 128 can include indentations that may have been formed by machines used to manufacture the tubing 128 or from the weight of other articles stacked on top of the package 154 during stocking. Regardless of the mechanism causing such deformation, an inner dimension 156 of the deformed portion of the tube 128 can become sufficiently restricted that the likelihood of clogging at the deformed portion is increased.

During some surgery, such as orthopedic surgery, significant amounts of bodily tissue pass through the suction tube. Existing suction tubes having a 5-6 millimeter diameter develop a problem when larger pieces of bodily tissue reach a bent section in the tube. The narrower diameter, as illustrated in Figure 19, impedes passage of the tissue, adversely affecting the suction performance.

As noted above, such bent sections arise from many sources, including storing the suction hose coiled for a prolonged time prior to use. Figure 17 illustrates how a coiled suction tube generates the cross-sections illustrated in Figures 18 and 19. After prolonged coiled storage, for example, suction tubing has tendency to revert to its coiled state when in use. This can create the bent sections of tubing during surgery.

Existing suction hoses typically have a restricted tip, inhibiting suction of larger pieces of bodily tissue. Those bodily tissue pieces which can pass through the restricted tip can cause a blockage in a bent section of existing suction tubing because the inner diameter of the bent tubing is smaller than the opening in the restricted tip.

Thus, Applicant submits that the devices of Claims 122, 124, and 128 **PERFORM DIFERENTLY** than the devices disclosed in the Bryan reference. In fact, the devices of Claims 122, 124, and 128 provide an improvement is avoiding interruptions of a surgical procedure. A further discussion of such benefits is disclosed in the specification at paragraphs 0036-0039 of the present Application.

The Examiner cites Gardner v. TEC Systems, Inc. for the proposition that the only difference between the prior art and the claims was a recitation of relative dimensions of the

claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device. 725 F.2d 1338 (Fed. Cir. 1984).

However, Gardner states, "Surely, the patent law does not attach uniqueness to dimensional claims that have **no significance in the operation of the claimed invention**." Id. at 1347. (Emphasis added).

Claims 122, 124 and 128, however, recite devices that provide **a significant effect** on the operation of suction devices during surgery. This effect is explained fully in the specification at the above-referenced paragraphs.

Thus, Applicant respectfully requests the Examiner withdraw the rejection of Claims 122, 124, and 128 and to pass these claims to allowance.

Additionally, Applicant submits that Claims 123, 125, 126, and 129-133 patentably define over the prior art not only because they depend from one of Claims 122, 124, or 128, but also on their own merit.

As noted above, Claim 129 has been amended to depend from Claim 128. Thus, the present rejection of Claim 129 is now moot.

SUMMARY

For the reasons described above, Applicant respectfully request the Examiner withdraw the objection to the drawings and the rejection of the claims and pass Claims 122-126 and 127-133 to allowance.

The undersigned has made a good faith effort to respond to all of the rejections and objections in the case and to place the claims in condition for immediate allowance. Nevertheless, if any undeveloped issues remain or if any issues require clarification, the Examiner is respectfully requested to call Applicant's attorney in order to resolve such issue promptly.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: June 4, 2007 By: /Michael Guiliana/

Michael A. Guiliana
Registration No. 42,611
Attorney of Record
2040 Main St.
Fourteenth Floor
Irvine, CA 92614
Customer No. 20,995
(949) 760-0404

3838525
060407